

REMARKS

This Response is submitted in reply to the Office Action mailed February 10, 2004. Claims 1, 15, 16, 17, 25 to 27, 33, 36, 37, 38, 40, 43, 44, 45, 46, 47, 48, 49, 51, 52, 54 and 61 have been amended. No new matter has been added through these amendments.

A Supplemental Information Disclosure Statement is submitted herewith. A Petition for a Three-Month Extension of Time to respond to the Office Action is submitted herewith. A check in the amount of \$1130.00 is submitted herewith to cover the cost of the Supplemental Information Disclosure Statement and the cost of the three-month extension of time. Please charge deposit account number 02-1818 for any insufficiency of payment or credit for any overpayment.

The Office Action rejected Claims 1, 4, 5, 8, 9, 15, 33 and 34 under U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,595,859 to Lynn ("Lynn"). Applicants have amended the claims to include a game operable upon a wager to overcome these rejections and to place this application in condition for allowance.

Lynn is directed to an internet marketing method and game that "players are encouraged to play ... as many times as they like, and with each play, one or more advertisements are displayed on the screen outside the picture." (Abstract) The game encourages the player to "play as many times as you like for free!" (Column 4, 67; Column 5, Line 1; Column 5, Lines 18 to 22; Fig. 3, 84). The game is centered around a point and click system. The game includes a screen display which includes a game image made up of a large number of individual pixels. At least one of the pixels or image area locations is designated and stored as a winning location. The player is encouraged to select a pixel or image area location on the game image, attempting to pick a winning location. After the player picks one of the areas, the selected pixel or image area location is compared to one or more stored prize winning pixels or image areas. If the location of the selected pixel or image area matches the pixel or image area selected and stored, the player wins a prize. If the selected pixel or image area location does not match the winning pixel or image area location, the server presents one of a variety of response pages. For example, as the player selections get closer to

a winning location, the game generates a response page by producing a message, such as "Friend, you are getting warmer." Players are encouraged to play the game as many times as they like. With each play, one or more advertisements are displayed on the screen outside the picture as well as on losing response pages with each additional play of the game.

In one example, the game page includes a large image of a money tree with a number of images and dollar bills on the tree. A message invites the player to play as many times as they like for free. The player clicks on one of the dollar bills. If the selected bill is a winner, the award is unmasked and is awarded to the player. When the player picks a dollar bill that is not associated with an award, the game generates a response page producing a message, such as "Friend, you are getting warmer." With each play, the game displays one or more advertisements to the player.

The principal object of Lynn is to provide an internet marketing game and method which encourages potential customers to visit the web sites of game sponsors. Another object of the game of Lynn is to provide a marketing game in which a player is encouraged to repeatedly play the game thus repeatedly exposing the player to the advertisements of game sponsors. That is, the marketing game of Lynn is designed to promote access to a web site which hosts the game, and to keep potential customers occupied on the web site for exposure to different advertisements or to a few advertisements repeatedly. This is all at no cost to the player.

Amended independent Claim 1 is directed to a gaming device which includes a primary game operable upon a wager by a player. The gaming device includes, in combination with other elements, a processor which communicates with the display device. The gaming device includes a secondary game which is triggered upon an occurrence of a triggering event associated with the primary game. The secondary game includes a target set including a plurality of player selectable symbols. At least one of the symbols in each target set is designated by the processor as a target symbol. The gaming device includes a symbol selector which is in communication with the processor. The secondary game includes at least one relationship indicator controlled by the processor which identifies a relationship between the target symbol and the

symbols selected by a player using the symbol selector. The gaming device includes an award based on the target symbol, whereby the award is provided to the player after the player picks the target symbol in the secondary game.

Lynn does not include each and every element of amended independent Claim 1. Lynn does not include a primary game operable upon a wager by a player. It specifically allows the player to play as many times as they like for free. Therefore, Lynn does not include each and every element of amended independent Claim 1. For the above-stated reasons, it is respectfully submitted that amended independent Claim 1 is patentably distinguished over Lynn and is in condition for allowance.

Claims 4, 5, 8, 9, and 15 depend directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to amended independent Claim 1 and because of the additional features recited in these claims.

Amended independent Claim 33 and dependent Claim 34 (depending directly from amended independent Claim 33) are directed to a gaming device which includes a base game operable upon a wager by a player. The gaming device includes, in combination with other elements, a bonus game triggered upon the occurrence of an event associated with the base game. A target set which includes a plurality of numbers is displayed to a player in the bonus game. At least one of the numbers is randomly designated as a target number by the processor. The gaming device includes a relationship indicator in the bonus game controlled by the processor which identifies the relationship between a target number and the numbers picked by the player using the number selector where the player picks the numbers in the target set until the player picks the target number.

Lynn does not include each and every element of amended independent Claim 33. Lynn does not include a game operable upon a wager by a player. Lynn does not include a target set displayed to a player which includes a plurality of numbers where at least one of the numbers is designated as a target number. The selections of Lynn do not include displaying a plurality of numbers in a target set. The selections in Lynn are masked. For the above-stated reasons, Applicants respectfully submit that amended

independent Claim 33 and dependent Claim 34 are patentably distinguished over Lynn and are in condition for allowance.

The Office Action rejected Claims 3, 6, 7, 10 to 12, 14, 17, 18, 20 to 23, 25, 27, 29 to 31, 35, 36, 38, 41 to 53 and 61 to 64 under 35 U.S.C. §103(a) as being unpatentable over Lynn in further view of U.S. Patent No. 6,159,097 to Gura ("Gura"). Applicants respectfully submit combining Lynn with Gura fails to establish a prima facie case of obviousness as any such combination renders the game in Lynn inoperable for its intended purpose.

Gura is directed to a gaming device which includes a basic game and a bonus game. The bonus game includes a screen with eight different characters around a table with an item in the center of the table. In the game, the item is stolen and the player is instructed to choose the person who stole the item from the table. In one embodiment of the gaming device of Gura, the player uses a touch screen to select the character. There are two possible outcomes once a character is chosen by the player. The character is either innocent or guilty. If the selected character is innocent, then the character undergoes an animated transition to innocence. If the selected character is guilty, then the guilty character speaks one of three guilty phrases, is stamped "guilty" and is given a new appropriate facial expression. The player is awarded a primary bonus based on the number of selections required to find the guilty character. The fewer the number of selections it takes the player to find the guilty character, the greater the primary bonus. If the player finds the guilty character with his or her first selection, the player is awarded a primary bonus of 250 credits multiplied by the number of active paylines. If the player finds the guilty character with his or her second selection, the player is awarded a primary bonus of 200 credits multiplied by the number of active paylines. Thus, the primary bonus awarded to the player decreases incrementally for each player selection.

Gura includes three additional bonus features. In the accomplice feature, the guilty character has an accomplice and the player finds the accomplice by continuing to select the characters. The finding of the accomplice adds a supplemental bonus to the primary bonus that was already awarded for finding the guilty character. In the stolen

item feature, the guilty character has another stolen item on him. This feature awards the player with a supplemental bonus in addition to the primary bonus already awarded for finding the guilty character. In the go-to-a-suspect's-hideout feature, the character flees the scene of the crime and the player must find the hiding place of the guilty character. Similar to the primary bonus game, the player receives an award based on the number of selections it takes the player to find the hiding place of the guilty character, but in the second game, the award is in the form of a payout multiplier.

The award in the primary bonus game in Gura is based on the number of selections it takes a player to find the guilty character. Gura does not teach, disclose, or suggest a plurality of target sets which each include a target symbol which is associated with a value. The selections in the bonus game of Gura are not associated with values. The award instead is based on the number of selections it takes the player to find the character. The player receives a supplemental bonus in the accomplice feature and the additional stolen item feature. The award provided in the go-to-suspect's-hideout feature is based on the number of selections used by the player. Gura does not teach, disclose or suggest providing an award based on the values associated with the selected target symbols and on the order of the selected target symbols.

As previously discussed, Lynn is directed to an internet marketing method and game designed to promote time spent on the web site by keeping customers occupied on the web site to expose them to different advertisements or to a few advertisements repeatedly. The game is a point and click system which includes a game image made up of a large number of individual pixels. The player is encouraged to randomly select a pixel or image area location (masked selections) on the game image. The selected pixel or image area location is then compared to one or more stored prize winning pixels or image locations. The player receives an award if the selected pixel matches one of the stored winning pixels. Players are encouraged to play the game as many times as they like for free. With each play, one or more advertisements are displayed on the screen outside the picture and on losing response pages with each additional play of the game.

Applicants respectfully submit that Lynn and Gura are not combinable. "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." (MPEP § 2143.01, *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Also, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Combining Lynn with Gura fails to establish a *prima facie* case of obviousness as any such combination renders the game in Lynn inoperable for its intended purpose.

The intended purpose of the marketing game disclosed in Lynn is to keep potential customers on the web site which hosts the game for as long as possible for exposure to advertisements. Lynn specifically states that a player may play the internet marketing game as many times as a player wants at no cost.

Unlike Lynn, the invention disclosed in Gura is a gaming device that begins a basic game in response to a wager amount. Players may not continue to play the game indefinitely without inputting more money. Unlike Lynn, the game of Gura requires a wager. Adding the element of a wager in Gura to the game in Lynn goes directly against the intended purpose of the game of Lynn, which is to keep a player playing a game to expose them to advertisements as long as possible. Additionally, Lynn teaches away from adding the element of a wager when it specifically states that the player may play as many times as they want for free.

Applicants respectfully submit that Lynn and Gura are not combinable references. Applicants submit that the intended purpose of Lynn teaches away from combining Lynn with Gura in the manner referred to in the Office Action. For the reasons provided above, Applicants respectfully request that the rejections of Claims 3, 6, 7, 10 to 14, 16, 23 to 25, 27 to 32, 35, 36 to 40, 43 to 61, 63 and 64 based on the combination of Lynn with Gura be withdrawn.

Additionally, the Office Action states in regards to Claims 6, 7, 20, 29 to 31, 36, 49 and 50 that it would have been obvious to one of ordinary skill in the art at the time of

invention to have limited the number of picks the user may make and award the player based on the number of picks remaining as taught by Gura in the game of Lynn in order to limit the amount of play time per game while adding an additional enticement to the game with the prize modifier. Applicants respectfully disagree with this assertion for two reasons. First, the game of Gura does not teach providing a limited number of picks to a player. Gura teaches providing a limited number of selections which may vary according to the start-bonus outcomes. For example, the number of selections begins at nine. Due to a certain symbol combination, the game eliminates two of the selections. Now the player has seven selections to choose from instead of nine. This decrease in the number of selections increases the possibility of achieving higher awards associated with the selection because the game awards an outcome to a player based on the number picks used. Second, the intended purpose of the game of Lynn, as previously discussed, is to keep a player on the web site as long as possible to expose the player to advertisements. Limiting the amount of play time per game by limiting the number of picks directly contradicts the intended purpose of Lynn.

The Office Action states in regards to Claims 22 and 48 that Lynn allows the player to play indefinitely and accrues the awards as they are won. The Office Action asserts this reads on basing an award on the target symbols selected by the player in each of the target sets using all of the number of picks wherein the number of picks is understood as being limited by the player. Applicants respectfully disagree and traverse this statement. Allowing the player to play indefinitely goes directly against providing a player with a number of picks wherein the number of picks is understood as being limited by the player.

Claims 35, 36 and 38 depend directly and indirectly on amended independent Claim 33. Amended independent Claim 33 is directed to a gaming device which includes a base game operable upon a wager by a player. The gaming device includes, in combination with other elements, a bonus game triggered upon the occurrence of an event associated with the base game. A target set which includes a plurality of numbers is displayed to a player in the bonus game. At least one of the numbers is randomly designated as a target number by the processor. The gaming device includes

a relationship indicator in the bonus game controlled by the processor which identifies the relationship between a target number and the numbers picked by the player using the number selector where the player picks the numbers in the target set until the player picks the target number.

Neither Lynn nor Gura teach, disclose or suggest a gaming device which includes a target set displayed to a player which includes a plurality of numbers. The marketing game of Lynn includes a plurality of masked selections, some of which are associated with numbers. Lynn does not teach, disclose or suggest displaying a plurality of numbers or basing an award on the target numbers selected and on the order in which they are selected. Gura includes a plurality of selections and two of the bonus features include selections which are associated with a supplemental bonus. However, Gura does not teach, disclose or suggest displaying a plurality of numbers to a player.

Therefore, the gaming device resulting from the combination of Lynn and Gura, if combinable, does not teach, disclose or suggest displaying a target set which includes a plurality of numbers. Applicants respectfully submit that Claims 35, 36 and 38 are patentable over the gaming device resulting from the combination of Lynn and Gura, if combinable, and are in condition for allowance.

The Office Action rejected Claim 2 under 35 U.S.C. 103(a) as being unpatentable over Lynn in further view of U.S. Patent No. 5,342,047 to Heidel ("Heidel"). Applicants have amended independent Claim 1 (from which dependent Claim 2 depends directly) to overcome this rejection.

Lynn, as previously discussed, is directed to an internet marketing game designed to promote time spent on the web site by keeping customers occupied on the web site to expose them to different advertisements or to a few advertisements repeatedly. The game is a point and click system which includes a game image made up of a large number of individual pixels. The player is encouraged to randomly select a pixel or image area location (masked selections) on the game image. The selected pixel or image area location is then compared to one or more stored prize winning pixels or image locations. If the selected pixel matches one of the winning pixels, the player

wins a prize. Players are encouraged to play the game as many times as they like for free. With each play, one or more advertisements are displayed on the screen outside the picture and on losing response pages with each additional play of the game.

Heidel is directed to a video lottery terminal that employs touch screens to permit a number of different games to be played on the same machine and includes electromechanical buttons in conjunction with touch screen controls.

Applicants respectfully submit that Lynn and Heidel are not combinable for the reasons stated above with respect to the Gura reference. Applicants submit that the intended purpose of Lynn teaches away from combining Lynn with Heidel. Heidel is directed to a video lottery terminal with a touch screen and buttons. Lynn is directed to an on-line marketing game designed to keep players on a web site to repeatedly expose them to advertisements. Applicants submit combining the wagering element of Heidel destroys the intended marketing purpose of Lynn. Applicants respectfully request the rejection to Claim 2 be withdrawn.

The Office Action rejected Claims 16, 19, 32, 37 and 54 to 60 under 35 U.S.C. §103(a) as being unpatentable over Lynn in view of Gura in further view of U.S. Patent No. 6,159,097 to Kamille ("Kamille").

Kamille is directed towards a multiple play game in which the player is faced with a choice as to where the game ends. The odds against winning increase progressively as the prize purse increases in size. The rewards the player attains are directly dependent upon the player's ability to tolerate risk. One embodiment of the game includes game pieces having masked numbers printed on them which are concealed by removable concealing means. The numbers include target numbers. An award is provided to the player for locating the target numbers. The player receives a bonus for uncovering all of the target numbers. The probability of selecting one of the target numbers changes each time the player uncovers one of the numbers.

Applicants respectfully submit that Lynn, Gura and Kamille are not combinable. Unlike Lynn, both the inventions disclosed in Gura and in Kamille are gaming devices that begin a basic game in response to a wager amount. Adding the element of a wager such as that in Gura and Kamille to the game of Lynn goes directly against the

intended purpose of Lynn, which is to keep players playing a free game to expose them to advertisements as long as possible.

Applicants respectfully request that the rejections to Claims 16, 19, 32, 37 and 54 to 60 based on the combination of Lynn, Gura and Kamille be withdrawn.

The Office Action rejected Claim 39 under 35 U.S.C. §103(a) as being unpatentable over Lynn in view of Gura and in further view of U.S. Patent No. 3,825,255 to Kennard ("Kennard"). Applicants respectfully submit that Lynn, Gura and Kennard are not combinable for the reasons stated above with respect to the combination of Lynn and Gura.

Kennard is directed to a game which automatically generates a hidden number by an electronic apparatus. A player tries to find the hidden number by inputting numbers. Once the number is inputted, an indication is provided on the display apparatus of the relationship between the player inputted number and the hidden number. The number selected by the player is transferred from its initial position to a higher or lower register where it is displayed. The player wins the game when the player inputs the hidden number.

Applicants respectfully submit that Lynn, Gura and Kennard are not combinable. Unlike Lynn, both the inventions disclosed in Gura and in Kennard are gaming devices that begin a game in response to a wager amount. Adding the element of a wager of Gura and Kennard into Lynn goes directly against the intended purpose of Lynn, which is to keep players playing a free game to expose them to advertisements as long as possible.

Applicants respectfully request that the rejection to Claim 39 based on the combination of Lynn, Gura and Kennard be withdrawn.

The Office Action rejected Claims 13, 24, 28 and 40 under 35 U.S.C. §103(a) as being unpatentable over Lynn in view of Gura and in further view of U.S. Patent No. 6,561,902 to Walker et al. ("Walker"). Applicants respectfully submit that Lynn, Gura and Walker are not combinable for the reasons stated above with respect to the combination of Lynn and Gura.

Walker is directed toward an electronic gaming device, such as a slot machine game, that defines a set of all possible elements of a game. The gaming device generates a set of location assignments for each of the elements, and assigns a location to each element in accordance with the set of location assignments. The player is presented with the locations and selects one or more masked locations, which are masked. Each received selection signal indicates an element from the set of possible elements. The selected elements are displayed either after each selection is made or after all the selections are made. The gaming device evaluates an outcome of the game in accordance with the selected elements. The outcome may or may not be based on the order in which the elements are selected.

Applicants respectfully submit that Lynn, Gura and Walker are not combinable. Unlike Lynn, both the inventions disclosed in Gura and in Walker are gaming devices that begin a basic game in response to a wager amount. Adding the element of a wager such as that in Gura and Kamille to the game of Lynn goes directly against the intended purpose of Lynn, which is to keep players playing a free game to expose them to advertisements as long as possible.

Applicants respectfully request that the rejections to Claims 13, 24, 28 and 40 based on the combination of Lynn, Gura and Walker be withdrawn.

An earnest endeavor has been made to place this application in condition for formal allowance and, in the absence of more pertinent art, such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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